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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,854	11/14/2003	Steven Shoup	2503162-991110	1890
26379	7590	03/09/2005	EXAMINER	
DLA PIPER RUDNICK GRAY CARY US, LLP 2000 UNIVERSITY AVENUE E. PALO ALTO, CA 94303-2248			PHASGE, ARUN S	
			ART UNIT	PAPER NUMBER

1753

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,854

Applicant(s)

SHOUP, STEVEN

Examiner

Arun S. Phasge

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/14/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (see pages 6, 7). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 112

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification only discloses the use of platinum plate (see page 6, lines 15-21). The carbon fiber can be added to the disclosure, since it is contained in the claims at the time of the filing of the application.

Double Patenting

Claims 1-4, 6-16 of this application conflict with claims 1-8, 11-14, and 16-19 of Application No. 10/979,606. 37 CFR 1.78(b) provides that when two or more

applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-4, 6-16 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-8, 11-14, 16-19 of copending Application No. 10/979,606. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 5-11, 13-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Wesley, U.S. Patent 3,829,368 in view of Hancock, U.S. Patent 3,754,147.

Wesley discloses the claimed method and system and method of installing and operating said system comprising an electrolytic cell that receives an input liquid and disassociates the input non-potable liquid into hydrogen and oxygen gas, the cell having first electrode that generates the hydrogen gas, the second

electrode that generates the oxygen gas, a second cell that receives the gases from the first cell, said second cell comprising a fuel cell which would meet the limitations recited in claim 1 and 5 (see figure and claims 1-37). The reference further disclosing the power supply that supplies power to the first cell and receives power from the second cell (see figure). The reference further discloses the further energy generation system that generates energy (see figure reference number 45). The set up and use of the system disclosed in the Wesley patent would accomplish the steps recited in claims 13-16. Further the placement into units and containers would be an obvious design modification well within the skill of the ordinary artisan, absent evidence to the contrary.

The reference fails to disclose the output that returns the excess liquid from the electrolysis cell to a reservoir, wherein the excess further cleans the contaminants out of the cell and removes dissolved materials contained in the input liquid.

The Hancock patent is cited to show the use of a recirculation of the excess water from the electrolysis cell which removes the dissolved material and contaminants from the cell (see figure 5 and col. 7, lines 41-68).

Consequently, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the disclosure of the Wesley patent with the teachings of the Hancock patent, because the Hancock patent teaches that the excess water removes the contaminants from the electrolysis.

Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wesley in view of Hancock as applied to claims above, and further in view of Best, WO 92/21861.

The combination of Wesley and Hancock fail to disclose that the energy generation system is a solar energy system.

The Best reference teaches the use of solar energy to power the electrolysis of water to obtain hydrogen and oxygen (see claim 6).

Therefore, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the disclosure of the Wesley patent with the teachings contained in the Best reference, because the Best reference teaches that such use of solar energy is routinely used in the art to provide energy to electrolyze water to obtain hydrogen and oxygen.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Best in view of Hancock applied as above.

The Best reference discloses the claimed method and system and method of installing and operating said system comprising an electrolytic cell that receives an input liquid and disassociates the input non-potable liquid into hydrogen and oxygen gas, the cell having first electrode that generates the hydrogen gas, the second electrode that generates the oxygen gas, a second cell that receives the gases from the first cell, said second cell comprising a fuel cell which would meet the limitations recited in claim 1 and 5 (see figure 1 and claims 1-11). The reference further disclosing the power supply that supplies power to the first cell and receives power from the second cell (see figure 1). The reference further discloses the further energy generation system that generates energy (see figure 1), wherein the further energy generation system is solar energy (see claim 6). The set up and use of the system disclosed in the Best reference would accomplish the steps recited in claims 13-16. Further the placement into units and containers would be an obvious design modification well within the skill of the ordinary artisan, absent evidence to the contrary.

The Best reference fails to disclose the output that returns the excess liquid from the electrolysis cell to a reservoir, wherein the excess further cleans the contaminants out of the cell and removes dissolved materials contained in the input liquid.

The Hancock patent is cited to show the use of a recirculation of the excess water from the electrolysis cell which removes the dissolved material and contaminants from the cell (see figure 5 and col. 7, lines 41-68).

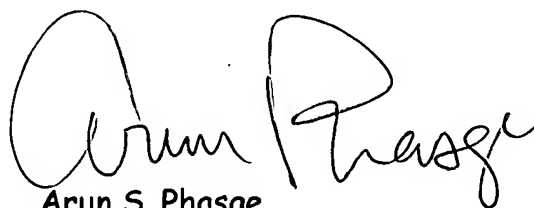
Consequently, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the disclosure of the Best reference with the teachings of the Hancock patent, because the Hancock patent teaches that the excess water removes the contaminants from the electrolysis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun S. Phasge whose telephone number is (571) 272-1345. The examiner can normally be reached on MONDAY-THURSDAY, 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Arun Phasge', with a large, stylized initial 'A'.

Arun S. Phasge
Primary Examiner
Art Unit 1753